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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,480	04/26/2001	Christoph Menzel	RXSD 1003-1	8158
22470	7590	09/06/2006	EXAMINER	
HAYNES BEFFEL & WOLFELD LLP			STRANGE, AARON N	
P O BOX 366			ART UNIT	
HALF MOON BAY, CA 94019			PAPER NUMBER	
			2153	

DATE MAILED: 09/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 09/830,480	Applicant(s) MENZEL ET AL.	
	Examiner Aaron Strange	Art Unit 2153	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 66-75 is/are allowed.
- 6) ☒ Claim(s) 1-63 is/are rejected.
- 7) ☒ Claim(s) 64 and 65 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>20060530;20060123</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. In the interest of clarifying the record, the Examiner would like to note that claim 63 was intended to be rejected in the Office action of 12/20/05 and claims 64 and 65 were objected to, as correctly noted by Applicant on page 13 of the remarks filed 6/20/06.

### ***Response to Arguments***

2. Applicant's arguments filed 6/20/2006 have been fully considered but they are not persuasive.

3. With regard to claims 15-22 and 53-61, Applicants traversal of the Examiner's assertion of Official Notice is inadequate and unpersuasive. Applicant has failed to specifically point out the supposed errors in the Examiner's action, including stating why the noticed fact is not considered to be common knowledge or well-known in the art. Applicant merely asserts that "it is the implementation of these hearing tests in combination with a computer program" that is the claimed invention.

This combination was addressed in the rejection of claims 15-22 and 53-61, which was based on the combination of Hou and knowledge of one of ordinary skill in the art. Since Hou teaches combining a well-known hearing test with a computer program, it would have been apparent to one of ordinary skill in the art at the time the invention was made that any well-known hearing test could be implemented in a similar manner.

4. With regard to claims 23,25,61 and 63, Applicants traversal of the Examiner's assertion of Official Notice is inadequate and unpersuasive. Applicant has failed to specifically point out the supposed errors in the Examiner's action, including stating why the noticed fact is not considered to be common knowledge or well-known in the art. Applicant merely asserts that "it is the implementation of hearing tests in combination with mobile phones and hand held computing devices" that is the claimed invention.

This combination was addressed in the rejection of claims 23,25,61 and 63, which was based on the combination of Hou and knowledge of one of ordinary skill in the art. Since Hou teaches conducting a hearing test over the internet, it would have been apparent to one of ordinary skill in the art at the time the invention was made that any device capable of accessing the internet (such as internet-enabled mobile phones or hand held computing devices) could be used to conduct the test.

#### ***Response to Amendment***

5. The declaration filed on 6/20/2006 under 37 CFR 1.131 has been considered but is ineffective to overcome the Hou (US 6,522,988) reference.

6. It appears that Applicant intends to show invention of the claimed subject matter prior to the Jan 24, 2000 filing date of US Provisional Application 60/177,695, to which Hou (US 6,522,988) claims priority, coupled with due diligence from prior to Jan 24, 2000 to the filing date of PCT/US00/40931, of which the present application is a national stage entry.

### **I. Conception**

7. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the Hou reference (1/24/00). While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

8. The affidavit or declaration and exhibits submitted by Applicant must clearly explain which facts or data Applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts to essentially a mere pleading, unsupported by proof or a showing of the facts", and, thus, does not satisfy the requirements of 37 CFR 1.131(b). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied upon by Applicant. (See MPEP 715.07, 1).

9. Exhibit A, which Applicant has cited as evidence of conception, appears to show the invention in general terms. However, the document has been cited as a whole, and Applicant has failed to show the specific parts of the document which are intended to

support the claimed invention. Applicant must give a clear explanation of the exhibits, pointing out exactly what facts are established and relied upon by Applicant (See MPEP § 715.07).

## **II. Diligence**

10. In determining the sufficiency of a 37 CFR 1.131 declaration/affidavit, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. (See MPEP 715.07(a)). However, in the interest of compact prosecution, the Examiner notes the following deficiencies. It should be noted that these remarks are designed to assist Applicant and should not necessarily be considered comprehensive.

11. Sections 3 and 4 of the declaration filed by the named inventors amounts to a mere assertion of diligence. Applicant is reminded that diligence requires that Applicants must be specific as to dates and facts for the entire period during which diligence is required. Several of the documents are described as being generated "no later than" a specified month. These dates are not specific enough to provide evidence of diligence. For example, the document specified as being generated "no later than February 2000" could have been generated prior to Jan 24, 2000. A document generated prior to January 24, 2000 provides no evidence of diligence during the critical period.

Furthermore, Applicant has not accounted for the time periods between the generation of the cited documents. Approximately a month passes between each event

listed. Some explanation and/or evidence of the events occurring during these intervals must be provided.

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966) (Merely stating that there were no weeks or months that the invention was not worked on is not enough.); *In re Harry*, 333 F.2d 920, 923, 142 USPQ 164, 166 (CCPA 1964) (statement that the subject matter "was diligently reduced to practice" is not a showing but a mere pleading). A 2-day period lacking activity has been held to be fatal. *In re Mulder*, 716 F.2d 1542, 1545, 219 USPQ 189, 193 (Fed. Cir. 1983) (37 CFR 1.131 issue); *Fitzgerald v. Arbib*, 268 F.2d 763, 766, 122 USPQ 530, 532 (CCPA 1959).

12. If Applicant intends to rely on diligence of the attorney of record, in preparing and filing the present application, a statement from the attorney indicating how the attorney exercised reasonable diligence in preparing and filing the application must be submitted. Emphasis should be placed on explaining the time period between the date shown in Mr. Menzel's notes (8/2/2000) and the filing of PCT/US00/40931 on 9/18/2000 (See MPEP 2138.06).

### ***Claim Rejections - 35 USC § 102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-14,24,26, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Hou (US 6,522,988).

15. With regard to claim 1, Hou discloses a method for conducting a hearing test using a computer program, comprising:

establishing a communication channel between an end station and a server in a communication network (Col 4, Lines 59-64);

executing a first portion of the computer program at the server, wherein the first portion of the computer program includes a component to deliver a second portion of the computer program to the end station from a resource coupled to the communication network (hearing assistant server transmits interface for performing test as well as results information to the local machine)(at least Col 5, Lines 25-27 and Col 13, Lines 59-63); and

executing the second portion of the computer program at the end station, wherein the second portion of the computer program includes logic executed at the end station that selects stimuli in response to user input and presents the selected stimuli (sound signals) to a user at the end station in accordance with a hearing test protocol



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(hearing test is conducted by user at the local machine)(Col 5, Line 1 to Col 8, Line 48, esp. Col 6, Lines 9-14).

16. With regard to claims 2-4, Hou further discloses that the communication network comprises a packet switched network, executing according to a standard internet protocol, TCP/IP (data network is the Internet) (Col 4, Lines 62-64).

17. With regard to claim 5, Hou further discloses that the second portion of the computer program includes logic that presents a set of stimuli (sound signals) to a user at the end station, and accepts input from the user responsive to the stimuli (Col 6, Lines 9-14).

18. With regard to claim 6, Hou discloses a method for conducting a hearing test using a computer program, comprising:

establishing a communication channel between an end station and a server in a communication network (Col 4, Lines 59-64);

executing a first portion of the computer program at the server (hearing assistant server transmits interface for performing test as well as results information to the local machine)(at least Col 5, Lines 25-27 and Col 13, Lines 59-63);

executing a second portion of the computer program at the end station (hearing test is conducted by user at the local machine)(Col 5, Line 1 to Col 8, Line 48, esp. Col 6, Lines 9-14), wherein the second portion of the computer program includes logic

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controlling a sensor at the end station to sense environmental data at the end station during the test (Col 14, Line 55 to Col 15, Line 32).

19. With regard to claim 7, Hou discloses a method for conducting a hearing test using a computer program, comprising:

establishing a communication channel between an end station and a server in a communication network (Col 4, Lines 59-64);

executing a first portion of the computer program at the server (hearing assistant server transmits interface for performing test as well as results information to the local machine)(at least Col 5, Lines 25-27 and Col 13, Lines 59-63);

executing a second portion of the computer program at the end station (hearing test is conducted by user at the local machine)(Col 5, Line 1 to Col 8, Line 48, esp. Col 6, Lines 9-14), wherein the second portion of the computer program includes logic to sense a set up at the end station during the test (calibration parameters are sensed and used during the test)(Col 14, Lines 21-54).

20. With regard to claim 8, Hou further discloses that the computer program includes test control, test data processing, and test sound signal components which are distributed between said first and second portions (test is controlled by server) (Col 6, Lines 9-14 ) (sounds are generated by local machine) (Col 6, Lines 63-64).

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21. With regard to claims 9 and 10, Hou further discloses that the computer program includes a component to deliver the second portion of the computer program to the end station from memory at the server (interface is stored at server until requested by local machine)(at least Col 5, Lines 25-27 and Col 13, Lines 59-63).

22. With regard to claim 11, Hou further discloses that the test control component executes a protocol responsive to the test data processing component involving interaction according to the input from the user and the environmental data sensed during the test (results are determined based on calibration information and user input) (Col 7, Line 63 to Col 8, Line 36).

23. With regard to claim 12, Hou further discloses that the test control component executes a protocol responsive to the test data processing component involving interacting according to the input from the user and the test set up data sensed during the test (results are determined based on calibration information and user input) (Col 7, Line 63 to Col 8, Line 36).

24. With regard to claim 13, Hou further discloses that the second component includes logic driving a graphical user interface to the user in conjunction with the set of stimuli, prompting the user to provide said input (Col 13, Line 59 to Col 14, Line 10).

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25. With regard to claim 14, Hou further discloses that the first portion manages presentation of stimuli for the test and the second portion controls production of the stimuli at the end station (Col 6, Lines 9-14).

26. With regard to claim 24, Hou further discloses that the end station comprises a home computer (Col 5, Lines 17-19)

27. With regard to claim 26, Hou discloses a method for conducting a hearing test using a computer program, comprising:

linking an user end station to a server using a communication network (Col 4, Lines 59-64);

allocating test control and data processing resources, using a communication network, between the user end station and the server (Col 6, Lines 9-14 and 63-64);

allocating test sound signal resources to the user end station, using a communication network, the test sound signal resources including logic that selects stimuli and presents the selected stimuli to a user at the end station in accordance with a hearing test protocol, and accepts input from the user responsive to the stimuli (Col 6, Lines 9-14);

generating a sound using the test sound signal resource (Col 6, Lines 9-14);

accepting and processing input using the test control and data processing resources (Col 6, Lines 9-14);

determining a status of a test according to a test protocol, and if the test is done, then storing a hearing profile for the user, and if the test is not done, then determining a next stimulus according to the test protocol using the test control resources, and returning to the step of generating a sound (Col 7, Lines 35-62).

28. With regard to claim 39, Hou discloses a method for conducting a hearing test using a computer program, comprising:

establishing a communication channel between an end station and a server in a communication network (Col 4, Lines 59-64);

executing a first portion of the computer program at the server, wherein the first portion of the computer program includes a component to deliver a second portion of the computer program to the end station from a resource coupled to the communication network (hearing assistant server transmits interface for performing test as well as results information to the local machine)(at least Col 5, Lines 25-27 and Col 13, Lines 59-63); and

executing the second portion of the computer program at the end station, wherein the end station includes sound processing resources for producing audio signals during the test (Col 5, Lines 6-8);

and wherein the second portion includes logic for calibrating the sound processing resources (Col 14, Line 55 to Col 15, Lines 45).

29. Claims 27-35,37,40-52 and 62 are rejected under the same rationale as claims 1-14, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

***Claim Rejections - 35 USC § 103***

30. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

31. Claims 15-23,25,36,38,53-61 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hou (US 6,522,988) in view of Official Notice.

32. With regard to claims 15-22, while the system disclosed by Hou shows substantial features of the claimed invention (discussed above), it fails to specifically disclose the various types of hearing tests capable of being performed.

The Examiner takes Official Notice that the types of tests claimed in claims 15-22 are old and well-known types of hearing tests. Each of these tests may be utilized to develop a hearing profile for a test subject, and would have been an advantageous addition to the system taught by Hou since they would have provided the testing entity with a more accurate depiction of the test subject's hearing loss.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to conduct any of the claimed tests, or any other type of hearing test, via the internet since it each of them would have provided additional information about a test subject's hearing loss.

33. With regard to claims 23 and 25, while the system disclosed by Hou shows substantial features of the claimed invention (discussed above), it fails to specifically disclose that the end station is an internet enabled mobile phone or a hand held computing platform.

The Examiner takes Official Notice that internet enabled mobile phones and hand held computing platforms are old and well-known means to access internet sites, such as the one taught by Hou.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to allow phones and handheld devices to access the site taught by Hou since it would have provided access to the hearing test to people without personal computers, allowing customized audio content and medical advice to be provided to those users as taught by Hou.

34. Claims 36,38,53-61 and 63 are rejected under the same rationale as claims 15-23 and 25, since they recite substantially identical subject matter. Any differences between the claims do not result in patentably distinct claims and all of the limitations are taught by the above cited art.

***Allowable Subject Matter***

35. Claims 66-75 are allowed.
36. Claims 64 and 65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

37. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Strange whose telephone number is 571-272-3959. The examiner can normally be reached on M-F 8:30-5:00.



38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AS  
8/25/2006



KRISNA LIM  
PRIMARY EXAMINER